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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,224	08/31/2000	Robert C. Mayes	10006908-1	4787

22879 7590 01/22/2004

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/653,224

Applicant(s)

MAYES, ROBERT C.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments, see paper no. 6, filed 10/17/03, with respect to the rejection(s) of claim(s) 1-21 under GARRIDO in view of ARTICLE 7/2000 has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 7-11, 12-15, 20-21 are rejected under 35 U.S.C. 103(a) as obvious over GARRIDO (US Patent 6,012,890) in view of BURTON et al (US Patent 4,598,376) alone or further in view of Article 3/1998 or 10/1987.

As for claim 1, GARRIDO discloses a method and apparatus for producing "custom made" manufactured book comprising: determining the size of the book, selecting the desired page size or book size based on customer's choice and manufacturing the book using the selected page and cover so that each book may be produced in a plurality of sizes if desired (see col. 7, lines 20-65 or (7: 20-65), 9: 5-20). GARRIDO is silent with respect to receiving the dimension of a book storage space prior to selecting the proper book size in relating to the book storage space; however, it's inherently included that the customer has in mind of where to store the book, bookshelf, bookcase, bookrack, book cabinet, etc., prior to selecting the book size so

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that it will fit into the desired storage space since one of the well known issue of buying a new book or making a new book is making sure that it will fit into its holder or storage area at home or workplace. As for the limitation of cover media, this is inherently included the manufacturing of book by GARRIDO since book normally consists of outside cover and inside pages and their dimension are nearly the same.

BURTON et al is cited to teach a well known concept for producing "custom made" manufactured or "made-to-measure process" items wherein the customer measures the size and shape of the desired items and send these information (dimensions) to the manufacturer for making the items to fit those dimensions and sending back to the customer a finished tailored items (suit) to fit its holder or wearer (see col. 2, lines 1-10, lines 57-67). It would have been obvious modify the "custom made" process of GARRIDO by including the step of receiving a dimension of a book (item) storage space prior to manufacturing the book (item) for making sure the book (item) fitting those dimension as taught by BURTON et al to produce a book (item) fitting the desired holder or storage area or bookshelf.

Article 3/1998 or Article 10/1987 is cited to teach well known issue in producing book is making sure it's fitting well or perfectly into a book storage space or bookshelf or pocket or any other convenient holder (see Article 3/1998, 1st page, 1st paragraph or Article 10/1987, page 2, last paragraph). It would have been obvious to modify the custom made process of GARRIDO and BURTON et al by taking one of the well known issue in producing book is making sure it's fitting well or perfectly into a book storage space or cabinet as shown by Article 3/1998 or Article 10/1987 and solving this issue by

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measuring the holder/storage area prior to manufacturing and sent these dimensions to the manufacturer as taught by BURTON et al.

As for claim 2, the production of more than one item is taught in GARRIDO on col. 7 or 9 above, or custom manufactured items by BURTON et al on col. 1, lines 5-10, col. 2, lines 50-60. Alternatively, the teaching for duplication of parts or more quantities are known and would have been obvious. As for claim 3, this is fairly taught on col. 7, lines 30-50 of GARRIDO or col. 2 of BURTON et al. As for claims 4-6, the steps for receiving payment information before or after manufacturing are well known/conventional to pay for the books and would have been obvious to a skilled artisan or inherently included in the teaching of GARRIDO or BURTON et al.

As for claims 7-9, it would have been obvious to a skilled artisan to set up system as in claims 7-9 to carry out the method steps as shown on claim 1 and further in view of GARRIDO col. 9, lines 5-15 which further teaches about the printing operation. As for claims 10-11, these are fairly taught in GARRIDO col. 2, line 65 to col. 3, line 30, col. 5, lines 40-67, col. 6, line 40 to col. 7, line 20. As for claims 12-15, 19-20, these are fairly taught on the same references as indicated on claims 10-11. Moreover, it would have been obvious to set up a program (computer readable media) to carry out the steps as shown in claim 1 above in view of the general teaching of Instant electronic (Internet) bookstore by GARRIDO.

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4. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

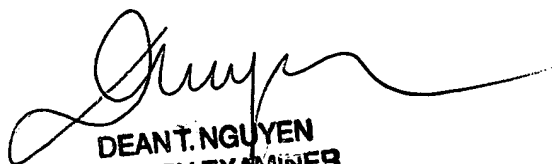
Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
January 12, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER